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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055812
Party	Defendant Susoix LLC
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	Motion to Dismiss Conservancy, Skateboarder Mark, FINAL.pdf (12 pages (75299 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Central Park Conservancy, Inc.

Opposer,

v.

Cancellation No. 92055812

Susoix LLC,

Applicant.

Susoix's Partial Motion to Dismiss

The Central Park Conservancy, Inc. (the "Conservancy") filed a Petition to Cancel ("Petition") Susoix's application for the mark Central Park Skateboarder Global Rolling (the "Skateboarder Mark") (Serial No. 85393670). In total, the Conservancy alleges three claims for opposing registration of the Skateboarder Mark. *See* Notice, ¶¶ 16-34. At issue in this partial motion to dismiss is the Conservancy's claim that the Skateboarder Mark falsely suggests a connection with an institution under Section 2(a) of the Lanham Act, 11 U.S.C. § 1052(a). As explained in the accompanying memorandum of law, this claim should be dismissed pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted.

Dated: 8/6/2012

Respectfully submitted,

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Central Park Conservancy, Inc.

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Cancellation No. 92055812

Susoix LLC,

Applicant.

**Memorandum in Support of
Susoix's Partial Motion to Dismiss**

Pursuant to Fed. R. Civ. P. 12(b)(6), Susoix LLC moves to dismiss the Conservancy's claim that the Skateboarder Mark falsely suggests a connection with an institution, in this case, the Central Park Conservancy. Section 2(a) of the Lanham Act is unique insofar as it protects the identity of institutions. *See* 11 U.S.C. § 1052(a). To qualify for this protection, though, an institution must establish two critical requirements: (1) the challenged mark uses the name of the institution or equivalent thereof, and (2) by using the name of the institution or equivalent thereof, the mark points "uniquely and unmistakably" to the institution. TMEP § 1203.03(e).¹

Here, however, the Conservancy has failed to allege facts supporting either of these critical elements for Section 2(a) protection. *First*, it is clear that the Skateboarder

¹ TMEP § 1203.03(e) sets forth a four-part test for a claim of false suggestion of connection with an institution. At issue in this motion to dismiss are the first two elements of the test. Susoix does not therefore address the two remaining elements of a false-suggestion-of-connection claim, namely: (3) the institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the institution is such that, when the mark is used with the applicant's goods or services, a connection with the institution would be presumed. *See* TMEP § 1203.03(e).

Mark does not contain the name of the Conservancy or equivalent thereof. *Second*, because the Skateboarder Mark does not use the name of the Conservancy or equivalent thereof, it cannot be said that the Skateboarder Mark points “uniquely and unmistakably” to the Conservancy. As a result, the claim is not “plausible on its face” and should be dismissed as a matter of law. *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

I. Background

Susoix LLC is a small business dedicated to endurance sports that provide a sustainable means of transportation, namely, cycling, skateboarding, and longboarding. On August 9, 2011, Susoix filed an application with the United States Patent and Trademark Office (“USPTO”) to register the Skateboarder Mark (Reg. No. 4022850).² As described in the application, the literal element of the mark includes the phrase “Central Park Skateboarder Global Rolling.” *See* Notice of Opposition, Ex. C. The mark is also playfully designed so as to depict a skateboard “rolling” in a horizontal plane. That is, the mark is “skateboard shaped,” has a curved nose and tail, lies in a horizontal plane, and even includes details such as the “screw holes for the trucks [where the wheels attach] on a typical skateboard deck.” *See id.* (providing an image of the mark).

Susoix registered the Skateboarder Mark in two services classes: (1) On-line wholesale and retail store services featuring products related to skateboarding, longboarding, cycling, and other endurance sports [IC 35], and (2) Personal coaching services in the field of skateboarding, longboarding, cycling, and other endurance sports

² Given Susoix’s focus on skateboarding, it also filed an application to register the mark Central Park Longboarder Global Rolling (Serial No. 85393670) (hereinafter the “Longboarder Mark”). The Conservancy has moved to oppose that mark on the same grounds it moves to cancel registration of the Skateboarder Mark. *See* Opposition No. 91205964.

[IC 41]. *Id.* The USPTO approved the mark and it was published in the Official Gazette on June 21, 2011. No opposition was filed within thirty days of publication. *See* TMEP § 202.01.

The City of New York, By and Through Its Parks Department (the “City”), instead filed a petition to cancel registration of the Skateboarder Mark. *See* Cancellation No. 92055800. As its principal claim, the City alleges that the Skateboarder Mark falsely suggests a connection with an institution -- Central Park -- in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). This claim is based on the fact that the Skateboarder Mark includes the words “Central Park.” Those words, the City claims, point uniquely and unmistakably to Central Park.

Susoix has filed a motion to dismiss the City’s claim on the grounds that Central Park is not an “institution” within the meaning of Section 2(a), 15 U.S.C. 1052(a). *See* Cancellation No. 92055800. The Federal Circuit has defined the term “institution” as “[a]n established organization,” and defined “organization” as a “body of persons . . . formed for a common purpose.” *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1173 (Fed. Cir. 2009) (quoting Black’s Law Dictionary 813, 1133 (8th ed. 2004)). Central Park does not fit within the boundaries of this definition. According to the City’s petition to cancel, it is a tourist attraction, a public park and a geographic location. It is not an organization. It is not a body of persons formed for a common purpose. It is not an “institution” within the meaning of Section 2(a). Susoix’s motion to dismiss the City’s false-suggestion-of-connection claim is currently pending before the Board. *See* Cancellation No. 92055800.

Four days after the City filed its petition to cancel, the Conservancy filed its own Petition to cancel the Skateboarder Mark. The Conservancy asserts that it is a not-for-profit corporation that manages Central Park. *See* Petition at ¶7. The Conservancy also states that it owns a number of federal trademarks, including the mark “Central Park Conservancy” which is registered for an array of goods and services. *Id.* at ¶1 (citing Registration Nos. 2261972, 2724447, 3760656, and 4053473).

Unlike the City, the Conservancy argues that the Skateboarder Mark falsely suggests a connection with an institution, in this case, the Conservancy. *See* Petition, at ¶30. There are, however, no allegations that the words “Central Park” refer to the name of the Conservancy or an equivalent thereof. Instead, the Petition alleges that “[t]he words Central Park primarily refers [sic] to Central Park, located in New York, New York.” *Id.* at ¶17.

II. Standard of Review

A motion to dismiss invokes a form of legal triage, a paring of viable claims from those doomed by law. In this way, a Rule 12(b)(6) motion to dismiss may be used to challenge the sufficiency of part of a pleading such as a single claim for relief. *See* Wright & Miller, Federal Practice and Procedure, Section 1358; *Drewett v. Aetna Cas. & Sur. Co.*, 405 F. Supp. 877, 878 (W.D. La. 1975). A Rule 12(b)(6) motion thus serves a useful purpose: “to allow the court to eliminate actions [or claims] that are fatally flawed in their legal premises and destined to fail, and thus spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993).

A motion to dismiss tests the legal sufficiency of a petition to cancel. When considering and addressing a Rule 12(b)(6) motion, the Board must accept as true all well-pleaded factual allegations, view those allegations in the light most favorable to the non-moving party, and draw all reasonable inferences in the opposer's favor. *See Tellabs, Inc. v. Makor Issues & Rights, Ltd.*, 551 U.S. 308, 322 (2007). Yet, the Board is “not bound to accept as true a legal conclusion couched as a factual allegation.” *Twombly*, 550 U.S. at 555.

To survive a motion to dismiss, a petition must contain sufficient factual matter, accepted as true, to “state a claim to relief that is plausible on its face.” *Id.* at 570. “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Ultimately, only a petition that states a plausible claim for relief survives a motion to dismiss. *Twombly*, 550 U.S. at 556. Determining whether the Petition in this case satisfies this standard is “a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Iqbal*, 556 U.S. at 679.

III. Discussion

As the Federal Circuit explained in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports, Inc.*, 703 F.2d 1373, 1376 (Fed. Cir. 1983), Section 2(a) was designed to protect “the name of an individual or institution which was not a technical ‘trademark’ or ‘trade name’ upon which an objection could be made under Section 2(d).” Given Section 2(a)’s unique focus on protecting the name of an institution, the *Notre Dame* court proceeded to set forth a test for determining whether a proposed mark falsely

suggests a connection with an institution. *Id.* “[T]he initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or ‘persona.’ ” *Id.* at 1376-77. It must therefore be shown that the mark appropriated the name of an institution (or equivalent thereof) such that the mark points unmistakably to the institution.

Similarly, under this Board’s precedent, it is well established, indeed “critical[,] that the matter for which the registration is sought *must be* the name or an equivalent which is sought to be appropriated by the applicant.” *In re White*, 73 USPQ2d 1713, 2004 WL 2202268, at * 6 (TTAB 2004) (emphasis added); *see also In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985) (the “mark sought to be registered is the same or a close approximation of the name or identity” of an institution). This emphasis on the name of the institution (or equivalent thereof) makes sense as it must also be shown that the mark, by appropriating the name “or equivalent thereof” of an institution, points “uniquely and unmistakably” to the institution. *See McDonnell Douglas Corp. v. Nat’l Data Corp.*, 228 USPQ 45, 1985 TTAB Lexis 144, at 13-14 (TTAB 1985). Logically, it would be difficult, if not impossible, to establish such an unmistakable relationship between a mark and an institution where the mark does not contain the name of the institution or equivalent thereof. *Id.*

Based on *Notre Dame* and this Board’s precedents, the TMEP has adopted a four-part test for a claim of false suggestion of connection with an institution. *See* TMEP § 1203.03(e). The first two requirements of the test track the “initial and critical requirement” for a Section 2(a) claim identified in *Notre Dame*, 703 F.2d at 1376-77. That is, the TMEP first requires a showing that the mark is “the same as, or a close

approximation” of the name used by an institution. TMEP §1203.03(e). It must then be shown that the mark, by appropriating the name of an institution or equivalent thereof, “points uniquely and unmistakably to that institution[.]” *Id.*

Pursuant to Rule 12(b)(6), the Board has dismissed Section 2(a) claims that fail to allege evidence supporting these two crucial requirements. For example, in *McDonnell Douglas*, 228 USPQ 45, the petitioner claimed that respondent’s use of the service mark “DataStat” falsely suggested a connection with respondent’s institution, McDonnell Douglas. Even though the petitioner alleged that the public associated the DataStat mark with McDonnell Douglas, *id.* at 15, the Board dismissed the claim because “the mark sought to be canceled is ‘DataStat’, which does not remotely resemble petitioner’s name, McDonnell Douglas” *Id.* at 13. Due to the lack of resemblance, the Court also concluded, as a matter of law, that the DataStat mark did not “‘uniquely and unmistakably’ point[] to petitioner’s corporate identity.” *Id.* at 15. Dismissal was therefore the appropriate remedy.

So too here dismissal is appropriate. There are no allegations in the Petition that the Skateboarder Mark uses the name (or equivalent thereof) of the Conservancy. Nor could there be such an allegation. The Skateboarder Mark contains the literal element “Central Park Skateboarder Global Rolling.” It does not include the name of the Central Park Conservancy Inc. or an equivalent thereof. Because the Conservancy has failed to establish this initial and critical requirement of a Section 2(a) claim, *see Notre Dame*, 702 F.3d at 1376-77, the claim must be dismissed as a matter of law. *See McDonnell Douglas*, 228 USPQ 45, at *16.

This result finds support in *United States Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497, 1984 TTAB Lexis 79 (TTAB 1984) (“*Olymp*”). There, the United States Olympic Committee opposed registration of the mark “Olymp” on the grounds that the mark falsely suggested a connection with an institution, namely, the United States Olympic Committee. *Id.* at *1-2. This claim was based on the fact that “the applicant’s mark ‘OLYMP’ is entirely encompassed in opposer’s OLYMPIC mark and the former constitutes the initial and major part of the later.” *Id.* at *4. Despite this similarity, the Board promptly dismissed the Section 2(a) claim because “there [was] no proof that ‘OLYMP’ is perceived as an alternate designation for opposer, United States Olympic Committee.” *Id.* at 6.

By the same token, there are no allegations supporting an inference that the Skateboarder Mark would be perceived as an alternate designation for the Conservancy. The Skateboarder Mark and the name of the Conservancy share two words in common: Central Park. The term Central Park is not, however, an alternate designation for the Conservancy. Quite to the contrary, the Petition alleges that “[t]he words Central Park primarily refers [sic] to Central Park, located in New York, New York.” Petition, ¶17. This allegation defies any claim that Skateboarder Mark uses an alternate designation for the Conservancy. It is thus quite clear that the Skateboarder Mark does not resemble the name of the Conservancy. For this reason alone, the claim must be dismissed for failure to state a claim. *See Olymp*, 224 USPQ 497, at *6; *see also American Speech-Language-Hearing Assoc.*, 224 USPQ 798, 1984 TTAB Lexis 19, at *19 (TTAB 1984).

The Skateboarder Mark’s failure to use the name of the Conservancy (or equivalent thereof) leads to a second reason for dismissal: the Skateboarder Mark does

not point “uniquely and unmistakably” to the Conservancy. *See American Speech*, 1984 Lexis TTAB 19, at * 19. The Petition alleges that the Skateboarder Mark is highly similar to some of the Conservancy’s marks. Petition, ¶25. Such an allegation cannot, however, be equated with an allegation that the Skateboarder Mark – which does not contain the name of the Conservancy or equivalent thereof – points uniquely and unmistakably to the Conservancy. *See McDonnell Douglas*, 1985 Lexis TTAB 144, at *15; *see also Olymp*, 224 USPQ 497, at *6. “To hold otherwise would be, in effect, to hold that Section 2(d) and that portion of Section 2(a) concerning the false suggestion of connection with persons, living or dead, [or institutions] are identical claims under the Trademark Act. Such a holding would do violence to Section 14 of the Act, which makes a distinction between Section 2(a) claims (which may be asserted against registrations more than five years old) and Section 2(d) claims (which may not be asserted against such registrations).” *American Speech*, 1984 TTAB Lexis 180, at *5. The claim should thus be dismissed for failure to allege proof supporting the second element of a Section 2(a) claim. TMEP § 1203.03(e).

To avoid this result, the Conservancy could argue that the Skateboarder Mark suggests a false connection with Central Park, New York City. After all, the Skateboarder Mark does include the words “Central Park”, which is term form the park. This argument is, however, flawed for two reasons. First, Central Park is not an institution within the meaning of Section 2(a). The Federal Circuit has defined the term “institution” as “[a]n established organization,” and defined “organization” as a “body of persons . . . formed for a common purpose.” *Shinnecock Smoke Shop, supra*, 571 F.3d at 1173 (quoting Black’s Law Dictionary 813, 1133 (8th ed. 2004)). Central Park does not

fit within the boundaries of this definition. According to the Notice, Central Park is a generally known geographic location. Notice, ¶ 18. It is not an organization. It is not a body of persons formed for a common purpose. It is not an “institution” within the meaning of Section 2(a). Therefore, there is no basis for a Section 2(a) claim that the Longboarder Mark falsely suggests a connection with Central Park. This may explain why the Conservancy awkwardly argues that the Longboarder Mark, which does not include the name of the Conservancy, falsely suggests a connection with the Conservancy – a not-for-profit corporation and thus likely an institution within the meaning of Section 2(a).

Second, even assuming Central Park is an “institution” within the meaning of Section 2(a), the Conservancy lacks standing to raise a claim on behalf of the park. “[T]o raise a claim that a mark falsely suggests a connection with an institution under Section 2(a), the challenger must be the institution itself.” *Heroes, Inc. v. Boomer Esiason Hero’s Found., Inc.*, 1997 WL 335807 (D.D.C. June 6, 1997) amended, 1997 WL 350097 (D.D.C. June 16, 1997). Here, the Conservancy styles itself as “a not-for-profit organization that manages Central Park” and “is responsible for day-to-day maintenance and operation” of Central Park. Petition, ¶¶ 7, 8. That is not to say, however, that the Conservancy has standing to raise a claim on behalf of Central Park.

The Conservancy is thus left to allege that the Skateboarder Mark falsely suggests a connection with the Conservancy itself. The Skateboarder Mark does not, however, contain the name of the Conservancy (or an equivalent thereof) and for this reason alone the claim should be dismissed. Furthermore, because the Skateboarder Mark does not contain the name of the Conservancy or equivalent thereof, it does not point “uniquely

and unmistakably” to the Conservancy. TMEP §1203.03(e). For these two reasons, the claim is not “plausible on its face.” *Twombly*, 550 U.S. at 570.

WHEREFORE, Susoix respectfully prays that the Board dismiss the Conservancy’s Section 2(a) claim pursuant to Fed. R. Civ. P. 12(b)(6).

Dated: 8/6/2012

Respectfully submitted,

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing motion to dismiss and memorandum in support thereof has been served on the City by electronic transmission mutually agreed upon by the parties to:

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